

**REMARKS**

The Office Action mailed March 4, 2009 ("Office Action") and cited reference have been received and considered. Claims 1-3, 5-18, 20-25, 27-47, 49-62, 64-69, 71-84, 86-88 and 93-97 are pending. Claims 1-3, 5-18, 20-25, 27-47, 49-62, 64-69, 71-84, 86-88 and 93-97 are rejected. No new matter is added. Entry of the amendments to the claims and the replacement drawings is respectfully requested. Claims 19, 63, and 85 were previously cancelled without prejudice or disclaimer. Reconsideration of the current rejections in the present application is also respectfully requested based on the following remarks.

Applicant notifies the Examiner that the pending claims of this application are related to the pending claims U.S. Application No. 09/777,353, published as U.S. Pub. No. 2002/0107788, now abandoned.

Applicant has amended independent claims 1, 45, 67, 93-96 to recite a notification *after* the occurrence of one or more triggering events. This amendment is intended to broaden the respective claims by allowing the notification to occur any time after the triggering event. Support for the amendments can be found at least on pp. 33-34 of the present specification.

**Claim Rejections Under 35 U.S.C. §101**

On pages 2-4 of the Office Action, claims 1-3, 5-18, 20-25, 27-47, 49-62, 64-69, 71-84, 86-88 and 93-97 were rejected under 35 U.S.C. §101 as allegedly reciting non-statutory subject matter. Applicant respectfully traverses this rejection.

**Claims 1-3, 5-18, 20-25, 27-47, 49-62, 64-69, 71-84, 86-88, and 97 Recite Statutory Subject Matter**

Despite disagreeing with the non-statutory subject matter rejection, Applicant has amended the claims to recite that the methods and systems of the claimed inventions comprise a

computer processor that performs various functions. Support for the amendments is found in the present disclosure at least on pp. 11-12 and pp. 2037-38.

Claims 93 and 94 Recite Statutory Subject Matter

Claim 93 recites, *inter alia*:

a computer readable storage medium; and  
instructions carried on the computer readable storage medium;  
wherein the instructions are configured to be readable from the at least  
one medium by at least one processor and thereby cause the at least one  
processor to operate so as to

Claim 93 recites a computer readable storage medium that is configured to be readable on a particular machine, i.e., *a processor*. Accordingly, claim 93 represents statutory subject matter since it meets the first prong of the *Bilski* test by being tied to a particular machine. Furthermore, “[a] claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer’s functionality to be realized, and is thus statutory.” MPEP §2106.01. See also Ex Parte Bo Li, 88 USPQ2d 1695 (BPAI 2008) (holding that a “Beauregard Claim” of this nature be considered statutory at the USPTO as a product claim).

Claims 95 and 96 Recite Statutory Subject Matter

On page 4 of the Office Action, the Examiner alleges that claims 95 and 96 “have the problem that their code is not clearly machine executable.” In order to clarify the claimed invention, Applicant has amended claims 95 and 96 accordingly. Applicant submits that the claims represent statutory subject matter in the form of a Beauregard Claim, which has been held by the Board of Patent Appeals and Interferences to represent statutory subject matter. See, e.g., Ex Parte Bo Li.

Therefore, Applicant respectfully requests the withdrawal of the §101 rejection of claims 1-3, 5-18, 20-25, 27-47, 49-62, 64-69, 71-84, 86-88 and 93-97.

**Claim Rejections Under 35 U.S.C. §112, ¶2**

On page 5 of the Office Action, claim 94 is rejected as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Despite disagreeing with the §112, ¶2 rejection of claim 94, Applicant has amended claim 94 and submits that the claim satisfies §112, ¶2. Therefore, Applicant requests the withdrawal of the §112, ¶2 rejection of claim 94.

**Objections to the Drawings**

On page 5 of the Office Action, the drawings filed February 25, 2004 are objected to as being informal and slightly illegible. Applicant is submitting replacement sheets for Figures 1-25 with this response. Applicant submits that the replacement drawings overcome the Examiner's objections.

**Rejections of Claims 1-3, 5-18, 20-25, 27-47, 49-62, 64-69, 71-84, 86-88 and 93-97 Under 35 U.S.C. § 103(a)**

On pages 6-11 of the Office Action, claims 1-3, 5-18, 20-25, 27-47, 49-62, 64-69, 71-84, 86-88 and 93-97 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent 7,287,008 ("Mahoney") in view of Official Notice. This rejection is respectfully traversed.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There are four separate factual inquiries to consider in making an obviousness determination: (1) the scope and content of the prior art; (2) the level of ordinary skill in the field of the invention; (3) the differences

between the claimed invention and the prior art; and (4) the existence of any objective evidence, or “secondary considerations,” of non-obviousness. Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966); see also KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007). An “expansive and flexible approach” should be applied when determining obviousness based on a combination of prior art references. KSR, 127 S. Ct. at 1739. However, a claimed invention combining multiple known elements is not rendered obvious simply because each element was known independently in the prior art. Id. at 1741. Rather, there must still be some “reason that would have prompted” a person of ordinary skill in the art to combine the elements in the specific way that he or she did. Id.; In re Icon Health & Fitness, Inc., 496 F.3d 1374, 1380 (Fed. Cir. 2007). Also, modification of a prior art reference may be obvious only if there exists a reason that would have prompted a person of ordinary skill to make the change. KSR, 127 S. Ct. at 1740-41.

*The Official Notice Regarding Draw Requests is Incorrect and is Traversed*

On page 14 of the Office Action, the Examiner provides remarks on Applicant’s arguments concerning Official Notice and draw requests (“argument A”). Applicant respectfully disagrees with the Examiner’s arguments. As the Examiner admits, “Mahoney does not expressly disclose or utilize the term ‘draw request.’” The Examiner alleges that “it is a notoriously old and well known fact that within a method and system as taught by Mahoney for loan origination and underwriting, that it would be obvious to include or interchangeably use the term ‘draw requests.’” Office Action, p. 14. The Examiner then continues and details the disclosure of Mahoney, ultimately concluding that “a user would then apply for a loan and at some point provide a draw request (amount) in order to have funds distributed to parties involved in the loan. The Examiner’s admission concerning the disclosure of Mahoney counters the Examiner’s own allegations. Mahoney “encompasses a data acquisition computer program

required for compiling loan origination information including financial and physical information . . . together with a credit request and loan application.” The Examiner notes that Mahoney discloses that the documents may be “pre-formatted and auto-populated.” Col. 2, lines 51-52. None of this disclosure relates to draw requests, which, as Applicant has previously stated, and the Examiner notes on p. 14 of the Office Action, are used in the administration of the loan, following the approval and underwriting process, to distribute funds to parties involved in the loan, such as vendors associated with a construction project.

Furthermore, the Examiner’s own previous admissions that draw requests may not be a typical part of the origination and underwriting process (see Office Action mailed September 22, 2008, p. 11) conflicts with asserting that the inclusion of draw requests would be well known or be common knowledge in the art “capable of instant and unquestionable demonstration as being well known.” See MPEP §2144.03(A). Mahoney would involve substantial changes to implement such a feature, a fact that Applicant has previously noted, and the Examiner has failed to address. Mahoney ultimately discloses generating a loan origination and underwriting report. See, e.g., Mahoney claim 1. Therefore, to include draw requests in Mahoney would not be well known or recognizable to one skilled in the art. Applicant requests that the Examiner provide documentary evidence supporting the Official Notice as alleged in the Office Action.

The Examiner’s allegations are based upon improper hindsight of combining the elements of the claimed invention into Mahoney. The Examiner has failed to “set forth explicitly” the basis of reasoning for the Official Notice and has not provided “specific factual findings predicated on sound technical and scientific reasoning to support” his conclusion. See MPEP §2144.03B. In the Examiner’s own words “[w]hile draw requests may not be a typical part of the origination and underwriting process.” Office Action mailed September 22, 2008, p.

11. This statement in the Office Action confirms the Applicant's position. If draw requests are not a typical part of the origination and underwriting process, how can the use of draw requests be capable of instant and unquestionable demonstration?

*Mahoney Fails to Render Independent Claim 1 Obvious*

Regarding independent claim 1, Mahoney does not disclose "assigning one or more of privileges and roles to each of the one or more participants." Applicant maintains the position (from the previous Office Action) that Mahoney fails to disclose this element or render this element obvious. Figure 11 of Mahoney depicts "an example of a deal analysis screen." Col. 11, line 16. Figure 12 depicts "an example suite of loan application screens." Col. 11, lines 36-37. Neither Figure depicts *assigning privileges and roles* to each of the participants. These Figures merely disclose information screens regarding the deal and loan. The terms *privileges and roles* are not found on these Figures, nor in the text of Mahoney. The only *participant* shown is in Figure 12 ("Borrower"). No other participants are depicted.

The Examiner alleges that "it is obvious for the assignment of privileges and roles to each of the participants involved in a transaction taught [*sic*], let alone within the disclosure of Mahoney." Office Action, p. 18. The Examiner continues that "while the express term 'privilege' and/or 'role' may not be found in these Figures, the drawings show, to one of ordinary skill in the art that the parties involved share an assignment of privileges and roles." Id. These two allegations by the Examiner run directly counter to one another. If the Figures of Mahoney fail to disclose even the terms of the claim, there is no suggestion or motivation regarding the disclosure of the claim elements in Mahoney. Therefore, one of ordinary skill in the art would not understand that the parties involved "share an assignment of privileges and roles." Furthermore, the claim does not recite a *sharing* an assignment of privileges and roles

but “assigning one or more of privileges and roles to each of the one or more participants.”

Applicant submits that Mahoney lacks the positive recitation of *assigning*. Additionally, incorporating such a feature into Mahoney would require substantial modifications and changes to Mahoney’s disclosure. Therefore, Mahoney fails to disclose or render obvious at least this element of the claimed invention. Also, Mahoney has further deficiencies as discussed below.

*Applicant Traverses the Reliance Upon Official Notice*

On page 7 of the Office Action, the Examiner admits the Mahoney fails to expressly disclose “a method wherein the one or more action comprise at least submitting one or more draw requests or specifically utilize the term ‘trigger’.” The Examiner relies upon Official Notice:

that it is a notoriously old and well known fact that within a method and system as taught by Mahoney for loan organization and underwriting, that it would be obvious to include or interchangeably use the terms ‘draw’, ‘requests’, ‘draw requests’, and ‘trigger’.

Applicant respectfully traverses this Official Notice. The Examiner is alleging that this series of diverse terms is interchangeable. Applicant submits that “draw” and “draw request” have certain meanings in relation to loans, such as construction loans, that one of ordinary skill in the art would appreciate. Replacing “draw requests” with “requests” in claim 1, for example, would alter the meaning of the claim. For example, claim 1 recites, *inter alia*, “submitting one or more draw requests.” If the word “draw” is deleted from the claim element, the claim would be altered in meaning. Likewise, if “draw request” was replaced with “trigger” the claim would also be altered in meaning and would read “submitting one or more triggers.” Furthermore, Applicant notes that “draw request” and “triggering events” appear in different claim elements, indicating different usage of the terms. The Examiner appears to be failing to give the claims a

reasonable interpretation in view of the specification, as required during examination. Therefore, Applicant requests the Examiner produce documentary evidence supporting the Official Notice.

Furthermore, in accordance with obviousness standards, a claimed invention combining multiple known elements is not rendered obvious simply because each element was known independently in the prior art, rather, there must still be some “reason that would have prompted” a person of ordinary skill in the art to combine the elements in the specific way that he or she did. Here, the claimed invention is structured in a particular way, combining certain elements. The Examiner has failed to provide any reason why the aforementioned terms are interchangeable as alleged by the Examiner and would be obvious to use interchangeably.

Accordingly, Applicant submits that Mahoney in combination with Official Notice fails to present a *prima facie* case of obviousness for at least claim 1 and Applicant respectfully requests the withdrawal of the obviousness rejection thereof.

*Mahoney in view of Official Notice Fails to Render Independent Claims 23, 45, 67, and 93-96 Obvious*

Independent claims 23, 45, 67, and 93-96 recite similar elements to independent claim 1, therefore the arguments above apply to claims 23, 45, 67, and 93-96 also. Therefore, claims 23, 45, 67, and 93-96 are allowable at least for the reasons given for independent claim 1. Applicant submits that claims 23, 45, 67, and 93-96 are allowable over the cited art, alone or in combination. Applicant respectfully requests the withdrawal of the rejections thereof.

*Mahoney in view of Official Notice Fails to Render Independent Claim 97 Obvious*

Independent claim 97 recites, among other things:

a draw module for:

(a) submitting one or more draw requests against the at least one loan, wherein the draw requests comprise one or more of a line item draw, an existing residential draw, or a new unit start draw;



- (b) processing the draw request; and
- (c) sending a draw package request, wherein the draw package request comprises one or more of a request for invoices and lien waivers.

On page 11, the Office Action rejects claim 97 under the same basis as claim 1. However, independent claim 97 is distinguishable from independent claim 1. The deficiency of Mahoney regarding draw requests has been noted above. Therefore, Applicant submits that claim 97 is patentable over the cited art and requests the withdrawal of the rejection thereof.

*The Dependent Claims are Allowable at Least  
by Virtue of their Dependency on the Independent Claims*

Claims 2, 3, 5-18, 20-22, 24, 25, 27-44, 46, 47, 49-62, 64-66, 68, 69, 71-84, and 86-88 are dependent upon at least one of independent claims 1, 23, 45, and 67. Therefore, since claims 1, 23, 45, and 67 are allowable over Mahoney as discussed above, claims 2, 3, 5-18, 20-22, 24, 25, 27-44, 46, 47, 49-62, 64-66, 68, 69, 71-84, and 86-88 are allowable at least by virtue of their dependency upon at least one of independent claims 1, 23, 45, and 67.

Therefore, based on the above arguments, Applicant respectfully submits that all claims are in condition for allowance and indication thereof is respectfully requested.

**CONCLUSION**

In view of the foregoing amendments and arguments, it is respectfully submitted that this application is now in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no fees are due for filing this Amendment. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicant also authorizes the Director to charge all required fees, fees under 37 C.F.R. §1.17, or all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

Date:

6/3/09



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